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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/717,315

11/19/2003

Tsuyoshi Sano

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08/21/2008

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EXAMINER

MCCLENDON, SANZA L

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

08/21/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|---------------------------------------|------------------------------------|--|
| Office Action Summary | Application No. 10/717,315 | Applicant(s) SANO ET AL. | |
| | Examiner Sanza L. McClendon | Art Unit 1796 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,11,12,18 and 19 is/are rejected.
- 7) ☒ Claim(s) 3-10 and 13-17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 4, 2008 has been entered.

Response to Amendment

2. In response to the Remarks received on 8/4/2008, the examiner has carefully considered the amendments.

3. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Response to Arguments

4. Applicant's arguments, see Remarks, filed 8/4/2008, with respect to claims 1-19 have been fully considered and are persuasive in part. The rejection of claims 1-10, 12-13 and 18-19 under 35 USC 103(a) as being unpatentable (obvious) over Yatake (6,670,409) has been withdrawn. The rejection of claim 11 under 35 USC 103(a) as being unpatentable over Yatake (6,670,409) as applied to claims 1-10, 12-13 and 18-19 in further view of EP 1219689 has been withdrawn. The rejection of claims 14-17 as being unpatentable over Yatake (6,670,409) as applied to claims 1-10, 12-13 and 18-19 in further view of GB 2370580 has been withdrawn.

5. Applicant's argument regarding the rejection of claims 1-2, 11-12 and 18-19 as being unpatentable over Nakamura et al are not persuasive. Applicant is arguing that Nakamura et al does not teach or suggest any weight ratio of components (i) to (ii) as found in the instant claims and that the only weight ratio shown in Nakamura et al is the ratio between the pigment (carbon black) and a thermoplastic resin emulsion (i) to (iii). The examiner disagrees. Nakamura et al teaches the content of the pigment is from 0.1 to 10 % by weight (column3, lines 66-67) and that

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the resin dispersant is found in amounts from 0.2 to 20% by weight (column 15, lines 59-62). Nakamura et al also teaches that the amount of water present in the resin dispersant is from 60 to 400 parts by weight based on 100 parts by weight of the resin component. The examiner deems with the teaching of the water amount and the teaching of the overall content of the resin dispersion (resin + water), the ratio of pigment to resin (solid content) can be calculated.

6. Calculating the resin content (solid content) in the emulsion:

60 to 400 parts water for every 100 parts resin would be a 25 to 60% resin content. ($400/100 = .25 * 100 = 25\%$; $60/100 = .60 * 100 = 60\%$).

A 0.2% resin emulsion would have from .05 parts solid ($25 * .2 = .05$) and a 20% resin emulsion would have from 5 part resin solid ($25 * 20 = 5$)

A 0.2% resin emulsion would have from .12 part solid ($60 * 0.2 = 0.12$) and a 20% resin emulsion would have 12 parts resin solid ($60 * 20 = 12$).

Therefore, when comparing the ratio of resin solid to pigment, wherein the resin emulsion is at 20--wt% (upper limit) based on having 400 parts water present, the amount of solid content is at least is at least 12.5 times the content of carbon black ($0.4/5 = .004/.05 = .08$ and $1/.008$ is 12.5). When comparing the ratio of resin solid to pigment, wherein the resin emulsion is at 20--wt% based on having 60 parts water present, the amount of solid content is at least is at least 30 times the content of carbon black ($.4/12 = .004/.12 = 0.033$ and $1/.033 = 30$). Therefore it is deemed that at the upper limit, i.e. 20 wt% resin dispersant (having 60 parts water present and 12 parts resin solid) is over 20 times or more the content of carbon black in the composition, i.e., 30 times. Therefore it is deemed that at least the upper limit as described above reads on the instant claims, thus the instantly claimed invention (20 or more time more) is found to overlap with reference (30 times more). The rejection of claims by Nakamura et al still stands.

Claim Rejections - 35 USC § 103

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 1-2, 12 and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura et al (6,114,411).

9. The rejection is adequately set forth in paragraph 3 of the Office Action mailed 12/7/2006 and is incorporated here by reference.

10. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura et al (cited above) as applied to claims 1-2, 12 and 18-19 above, and further in view of EP 1219689.

11. The rejection is adequately set forth in paragraph 3 of the Office Action mailed 12/7/2006 and is incorporated here by reference.

Allowable Subject Matter

12. Claims 3-10 and 13-17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

13. The following is a statement of reasons for the indication of allowable subject matter: these limitations were not found in the cited prior art.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanza L. McClendon whose telephone number is (571) 272-1074. The examiner can normally be reached on Monday through Friday 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sanza L McClendon/

Primary Examiner, Art Unit 1796

SMc